

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
W. KARL RENNER  
FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

## PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Applicant's or agent's file reference 06975-588WO1		Date of mailing (day/month/year) <b>06 MAR 2007</b>
<b>FOR FURTHER ACTION</b> See paragraph 2 below		
International application No. PCT/US05/42992	International filing date (day/month/year) 30 November 2005 (30.11.2005)	Priority date (day/month/year) 01 December 2004 (01.12.2004)
International Patent Classification (IPC) or both national classification and IPC IPC: <b>G06F 15/16 (2006.01), 15/173 (2006.01)</b> USPC: <b>709/206,239</b>		
Applicant AMERICA ONLINE, INC.		

1. This opinion contains indications relating to the following items:

- ☒ Box No. I      Basis of the opinion
- ☐ Box No. II      Priority
- ☐ Box No. III      Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV      Lack of unity of invention
- ☒ Box No. V      Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI      Certain documents cited
- ☐ Box No. VII      Certain defects in the international application
- ☐ Box No. VIII      Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (571) 273-3201	Date of completion of this opinion 22 September 2006 (22.09.2006)	Authorized officer Andrew Caldwell <i>for</i> <i>Michael L. Egan</i> Telephone No. 571-272-3581
--	--	---

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US05/42992

Box No. 1 Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of:

- ☒ the international application in the language in which it was filed  
☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 22<sup>1</sup>(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing  
☐ table(s) related to the sequence listing

b. format of material

- ☐ on paper  
☐ in electronic form

c. time of filing/furnishing

- ☐ contained in the international application as filed.  
☐ filed together with the international application in electronic form.  
☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US05/42992

**Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

Novelty (N)	Claims <u>31</u>	YES
	Claims <u>1-30 and 32-54</u>	NO
Inventive step (IS)	Claims <u>NONE</u>	YES
	Claims <u>1-54</u>	NO
Industrial applicability (IA)	Claims <u>1-54</u>	YES
	Claims <u>NONE</u>	NO

**2. Citations and explanations:**

Please See Continuation Sheet

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/US05/42992

Supplemental Box  
In case the space in any of the preceding boxes is not sufficient.

**V. 2. Citations and Explanations:**

Claims 1-30 and 32-54 lack novelty under PCT Article 33(2) as being anticipated by Low et al. (U.S. 2003/0018726 A1) hereinafter referred to as Low.

a. Regarding claim 1, Low teaches: receiving an electronic message and an indication of a sender-specified destination for the electronic message (paragraphs [0007] and [0012] on page 1); determining whether the destination is available to receive an electronic message using a first mode of communication (paragraphs [0033] and [0035] on page 3); determining whether a mobile telephone number is known by the sender to be associated with the destination (paragraph [0032] on page 3 and paragraph [0039] on page 4); and determining whether to transmit a communication that is based on the electronic message using the mobile telephone number wherein the determination to transmit is based on a determination that the destination is not available and that the mobile telephone number is known by the sender to be associated with the destination (paragraph [0044] on page 5).

b. Regarding claim 2, Low teaches: the electronic message comprises and instant message (paragraph [0012] on page 1); and the destination comprises an instant message identity (paragraph [0039] on page 4).

c. Regarding claim 3, Low teaches: the instant message identity comprises an identity that is not signed on to an instant message service, and determining whether the destination is available to receive an electronic message using a first mode of communication comprises determining whether the instant message identity is signed on to an instant message service, the method further comprising making a determination that the destination is not available if the instant message identity is not signed on to the instant message service (paragraph [0004] on page 1 and paragraph [0033] on page 3).

d. Regarding claim 4, Low teaches: the instant message identity comprises an identity that is signed on to an instant message service and is associated with an idle state (paragraph [0039] on page 4), and determining whether the destination is available to receive an electronic message using a first mode of communication comprises: determining whether the instant message identity is signed on to an instant message service, and determining whether the instant message identity is associated with an idle state if the instant message identity is determined to be signed on to the instant message service, the method further comprising making a determination that the destination is not available if the instant message identity is signed on to the instant message service and the instant message identity is associated with an idle state (paragraph [0033] on page 3, paragraph [0039] on page 4, paragraph [0042] on pages 4-5, and paragraph [0045] on page 5).

e. Regarding claim 5, Low teaches: determining whether the mobile telephone number is known by the sender to be associated with the destination comprises searching electronic storage for an association of the mobile telephone number and an instant message identity, and determining whether a mobile telephone number is known by the sender to be associated with the destination comprises identifying, in a collection of contact information associated with the sender, a stored association of the mobile telephone

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US05/42992

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

number and the instant message identity (paragraph [0039] on page 4).

f. Regarding claim 6, Low teaches: wherein the collection of contact information comprises one of an address book associated with the sender or a buddy list associated with the sender (paragraph [0004] on page 1).

g. Regarding claim 7, Low teaches: determining whether the mobile telephone number is known by the sender comprises searching the collection of contact information associated with the sender for a mobile telephone number associated with an instant message identity (paragraph [0039] on page 4).

h. Regarding claim 8, Low teaches: the instant message identity is associated with a screen name, and searching the collection of contact information associated with the sender for a mobile telephone number associated with an instant message identity comprises searching the collection of contact information associated with the sender for a mobile telephone number associated with the screen name associated the instant message identity (paragraph [0039] on page 4).

i. Regarding claim 9, Low teaches: identifying a user name associated with the instant message identity in a buddy list associated with the sender (paragraph [0004] on page 1 and paragraph [0039] and tables 1 and 2 on page 4), wherein: searching the collection of contact information associated with the sender for a mobile telephone number associated with an instant message identity comprises searching the collection of contact information associated with the sender for the user name, and determining that the mobile telephone number is known by the sender to be associated with the instant message identity comprises identifying, in the collection of contact information associated with the sender, a stored association of the mobile telephone number and the user name (paragraph [0039] and tables 1 and 2 on page 4).

j. Regarding claim 10, Low teaches: wherein a host system performs the receiving, the determining of whether the instant message identity is available, the determining of whether the mobile telephone number is known by the sender to be associated with the instant message identity, and the determining of whether to transmit the communication (paragraph [0039] and tables 1 and 2 on page 4).

k. Regarding claim 11, Low teaches: a client system performs the receiving, the determining of whether the destination is available, the determining of whether the mobile telephone number is known by the sender to be associated with the destination, and the determining of whether to transmit the communication (paragraph [0039] and tables 1 and 2 on page 4).

l. Regarding claim 12, Low teaches: enabling a text message to be sent to the mobile telephone number such that the text message is based on text of the electronic message (paragraph [0032] on pages 2-3).

m. Regarding claim 13, Low teaches: forwarding a text message to be sent to the mobile telephone number such that the text message is based on text of the electronic message (paragraphs [0011] and [0014-0016] on page 1, paragraph [0028] on page 2, and paragraph [0036] on page 3).

n. Regarding claim 14, Low teaches: receiving confirmation from the sender to enable transmission to the mobile telephone number, wherein determining whether to transmit a communication that is based on the electronic message to the mobile telephone number based on a determination that the mobile telephone number is known by the sender to be associated with the destination comprises only determining to transmit after receiving confirmation from the sender that the electronic message is to be transmitted to the mobile telephone number (paragraph [0028] on page 2 and paragraph [0039] on page 4).

o. Regarding claim 15, Low teaches: whether the destination prohibits transmission of communications to the mobile telephone number based on electronic messages (paragraph [0004] on page 1), wherein determining whether to transmit a communication that is based on the electronic message to the mobile telephone number based on a determination that the mobile telephone number is known by the sender to be associated with the destination comprises only determining to transmit after a determination is made that the destination does not prohibit transmission of communications to the mobile telephone number based on electronic messages (paragraph [0004] on page 1 and paragraphs [0030-0031] on page 2).

p. Regarding claim 16, Low teaches: receiving an indication of whether the destination prohibits transmissions of communications based on electronic messages to the mobile telephone number, wherein: determining whether the destination prohibits transmission of a communication based on the electronic message to the mobile telephone number comprises accessing the indication of whether the instant message identity prohibits transmissions, and determining whether to transmit comprises only determining to transmit after a determination is made, based on the accessed indication, that the destination does not prohibit transmissions of communications based on electronic messages to the mobile telephone number (paragraph [0039] on page 4).

q. Regarding claim 17, Low teaches: determining whether the destination is available to receive an electronic message addressed to the destination comprises determining whether the destination is signed on to an instant message service used to send the electronic message, and the determination that the destination is not available comprises a determination that the destination is not signed on to the instant message service (paragraph [0039] on page 4 and paragraph [0042] on pages 4-5).

r. Regarding claim 18, Low teaches: determining whether the destination is available to receive an electronic message addressed to the destination comprises determining whether the destination is signed on to an instant message service used to send the electronic message and determining whether the destination is away from a client system used to access the instant message service, and the determination that the destination is not available comprises a determination that the destination is signed on to the instant message service and a determination that the destination is away from the client system (paragraph [0039] on page 4 and paragraph [0042] on pages 4-5).

s. Regarding claim 19, Low teaches: the determining whether the destination is away from a client system used to access the instant message service comprises determining whether a user-configurable away indication is associated with the destination, and the determination that the destination is away from the client system comprises a determination that a user-configurable away indication is associated with the destination (paragraph [0039] on page 4 and paragraph [0042] on pages 4-5).

t. Regarding claim 20, Low teaches: receiving an electronic message and an indication of a sender-specified destination for the electronic message (paragraphs [0007] and [0012] on page 1); determining whether the destination is available to receive an electronic message using a first mode of communication (paragraphs [0033] and [0035] on page 3); determining whether a second destination using a second mode of communication is known by the sender to be associated with the destination (paragraph [0039] on

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US05/42992

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

page 4; and in response to a determination that the destination is not available and that a second destination using a second mode of communication is known by the sender to be associated with the destination, enabling transmission of a communication that is based on the electronic message to the second destination and using the second mode of communication (paragraph [0039] on page 4).

u. Regarding claim 21, Low teaches: selecting, based on a user preference, the second destination from multiple destinations (paragraph [0004] on page 1).

v. Regarding claim 22, Low teaches: the electronic message comprises an instant message, the destination comprises an instant message identity, and the first mode of communication comprises instant messaging (paragraph [0012] on page 1 and paragraph [0039] on page 4).

w. Regarding claim 23, Low teaches: second destination comprises a mobile telephone number, and the second mode of communication comprises sending a text message (paragraph [0012] on page 1 and paragraph [0039] on page 4).

x. Regarding claim 24, Low teaches: second destination comprises an electronic mail address, and the second mode of communication comprises sending an electronic mail message (paragraph [0012] on page 1, paragraph [0039] on page 4, and paragraph [0048] on page 6).

y. Regarding claim 25, Low teaches: the second destination comprises a telephone number, and the second mode of communication comprises sending a voice telephone message (paragraph [0032-0033] on pages 2-3).

z. Regarding claim 26, Low teaches: the second destination comprises an instant message identity available through a instant messaging service that is different from the instant messaging service that is associated with the destination (paragraph [0035] on page 3).

aa. Regarding claim 27, Low teaches: the instant message identity comprises an identity that is not signed on to an instant message service, and determining whether the destination is available to receive an electronic message using a first mode of communication comprises determining whether the instant message identity is signed on to an instant message service, the method further comprising making a determination that the destination is not available if the instant message identity is not signed on to the instant message service (paragraph [0039] on page 4).

bb. Regarding claim 28, Low teaches: the instant message identity comprises an identity that is signed on to an instant message service and is associated with an idle state, and determining whether the destination is available to receive an electronic message using a first mode of communication comprises: determining whether the instant message identity is signed on to an instant message service, and determining whether the instant message identity is associated with an idle state if the instant message identity is determined to be signed on to the instant message service, the method further comprising making a determination that the destination is not available if the instant message identity is signed on to the instant message service and the instant message identity is associated with an idle state (paragraph [0039] on page 4).

cc. Regarding claim 29, Low teaches: a list of potential message recipients selected by a user as significant to the user; a user identifier associated with each potential message recipient and configured as a conduit for message delivery to the associated potential message recipient using the computer service; and one or more forwarding indications that indicate whether a message addressed to a potential message recipient is to be forwarded to a mobile telephone number associated with the potential message recipient based on a determination that the mobile telephone number is known by the user to be associated with the potential message recipient (paragraph [0039] and tables 1 and 2 on page 4 and Fig. 7-9).

dd. Regarding claim 30, Low teaches: the one or more forwarding indications are displayed adjacent to the user identifier for the corresponding potential message recipient (paragraph [0040] on page 4 and Fig. 7-9).

ee. Regarding claim 32, Low teaches: the one or more forwarding indications comprise a first type of forwarding indication having a first presentation style that indicates that message forwarding to a mobile telephone number associated with a first potential message recipient associated with the first type of forwarding indication is enabled based on a determination that the mobile telephone number is known by the user to be associated with the potential message recipient, and the graphical user interface further comprises one or more forwarding indications of a second type wherein the one or more forwarding indications of the second type have a second presentation style that indicates that message forwarding to a mobile telephone number associated with a second potential message recipient associated with the second type of forwarding indication is enabled such that message forwarding is enabled by the second potential message recipient (paragraph [0039] on page 4).

ff. Regarding claim 33, Low teaches: a control for sending a message to at least one of the potential message recipients (paragraph [0004] on page 1).

gg. Regarding claim 34, Low teaches: list of potential message recipients comprises one of an electronic address book or a contact list for the computer service (paragraph [0004] on page 1).

hh. Regarding claim 35, Low teaches: the computer service comprises an instant messaging service, and the list of potential message recipients comprises a buddy list (paragraph [0004] on page 1).

ii. Regarding claim 36, Low teaches: user identifier comprises an address for communication inspired through interaction with the graphical user interface (paragraph [0004] on page 1).

jj. Regarding claim 37, Low teaches: a mobile blocking indicator that indicates that message forwarding to a mobile telephone is prohibited by a potential message recipient (paragraph [0039] on page 4).

kk. Regarding claim 38, Low teaches: a mobile forwarding indication that indicates that a mobile telephone associated with a potential message recipient is capable of receiving a text message (paragraph [0039] on page 4).

ll. Regarding claim 39, Low teaches: the list of potential message recipients includes categories of potential message recipients such that a category is associated with one or more potential message recipients (paragraph [0004] on page 1).

mm. Regarding claim 40, Low teaches: a first category is associated with one or more potential message recipients that are each associated with a forwarding indication, and a second category is associated with one or more potential message recipients that are not associated with the first category (paragraph [0004] on page 1, paragraph [0039] and table 1 and 2 on page 4, and Fig. 7-9).

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US05/42992

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

nn. Claims 41-54 contain similar limitations as those rejected in claims 1-30 and 32-40 and are rejected under the same rationale.

Claim 31 lacks an inventive step under PCT Article 33(3) as being obvious over Low in view of Blattner et al. (U.S. 2004/0179039 A1) hereinafter referred to as Blattner.

a. Regarding claim 31, Low does not explicitly teach: the one or more forwarding indications comprise icons. However, Blattner discloses: "Each of the avatars 805a-805r is a multi-dimensional character with depth of personality, voice, and visual attributes. In contrast to representing a single aspect of a user through the use of an unanimated, two-dimensional graphical icon, an avatar of the avatars 805a-805r is capable of indicating a rich variety of information about the user projecting the avatar," (paragraph [0089] on page 9). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have the forwarding indications comprise icons. "Properties of the avatar enable the communication of physical attributes, emotional attributes, and other types of context information about the user that are not well-suited (or even available) for presentation through the use of two-dimensional icons that are not animated. In one example, the avatar may reflect the user's mood, emotions, and personality. In another example, the avatar may reflect the location, activities and other context of the user. These characteristics of the user may be communicated through the appearance, the visual animations, and the audible sounds of the avatar," (paragraph [0089] on page 9 in Blattner). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the forwarding indications comprise icons in the system as taught by Low.

Claims 1-54 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.